

MTC 6888.2  
40-21(52925)C US  
PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of David A. Morgenstern  
Serial No: 10/687,541  
Filed October 16, 2003  
Confirmation No. 7748  
For USE OF METAL SUPPORTED COPPER CATALYSTS FOR REFORMING  
ALCOHOLS

Art Unit 1795

September 4, 2009

APPLICATION FOR PATENT TERM ADJUSTMENT  
PURSUANT TO 37 C.F.R. § 1.705(b)

COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

SIR:

In response to the June 10, 2009 Notice of Allowance in the above-referenced patent application, applicant respectfully requests reconsideration of the patent term adjustment determination. Pursuant to 37 CFR § 1.705(b), applicant submits the following statement of facts in support of this request for reconsideration.

The above-referenced application has the following events in its prosecution timeline:

1. The filing date of the application is October 16, 2003.
2. The first Office action was mailed on September 7, 2006, which was 630 days after the fourteen-month due date for the mailing of the first Office action on the merits.  
12/03/2009 LDIEP1 00000008 191345 10687541  
01 FC:1453
3. The response to the first Office action was filed on December 7, 2006, which was within the three-month shortened statutory period for reply.

4. A Requirement for Restriction/Election was mailed on March 13, 2007.

5. The response to the Requirement for Restriction/Election was filed on April 4, 2007, which was within the one-month shortened statutory period for reply.

6. A non-final Office action was mailed on June 14, 2007.

7. The response to the non-final Office action was filed on October 11, 2007, which was 27 days after the end of the three-month shortened statutory period for reply.

8. A final Office action was mailed on January 4, 2008.

9. A Request for Continued Examination was filed on May 5, 2008, which was 31 days after the end of the three-month shortened statutory period for reply.

10. A non-final Office action was mailed on August 6, 2008.

11. The response to the non-final Office action was filed on February 6, 2009, which was 92 days after the end of the three-month shortened statutory period for reply.

12. A Notice of Allowance was mailed on June 10, 2009, which was four days after the four-month period for responding to a reply.

According to 35 U.S.C. § 154(b), the term of a patent may be extended by one day for every day of Office delay specified by 35 U.S.C. § 154(b)(1)(A) ("Period A" type delays). Also, under 35 U.S.C. § 154(b)(1)(B), the term of a patent may be extended by one day for every day of delay caused by the Office in issuing a patent more than three years after the filing date, not including any time consumed by continued examination of the application requested by the applicant ("Period B" type delay).

Under 35 U.S.C. § 154(b)(2)(C), the period of adjustment of the term is reduced by a period equal to the period of time during which the applicant failed to engage in reasonable

efforts to conclude prosecution of the application. Moreover, to the extent that Period A and Period B type delays overlap, the period of any adjustment may not exceed the actual number of days the issuance of the patent was delayed. 35 U.S.C. § 154(b)(2)(A).

The patent term adjustment (PTA) calculated by the Office for the subject application as stated on the Notice of Allowance is 484 days. This calculation is based on the Period A type delays on the part of the Office of 634 days, reduced by 150 days of applicant delay. Figure 1, attached hereto, shows the Office's PTA calculation.

\* Applicant respectfully submits that the Office has failed to consider any Period B delay on the part of the Office in the in its calculation of PTA. Under the holding of *Wyeth v. Dudas*, 88 U.S.P.Q. 2d, 1538 (D.D.C. 2008), accumulation of PTA under a Period B type delay does not start until the day after the date that is three years after the filing date. Therefore, Period B type delay cannot overlap with Period A type delays until three years after the filing date of the application.

Period B type delay was not considered in the Office's PTA calculation for the subject application. As shown on attached Figure 2, the unaccounted for Period B type delay on the part of the Office was 566 days. The Period B type delay was calculated from the period of time from the day after the date that is three years after the filing date (October 17, 2006) until the filing of the Request for Continued Examination (May 5, 2008).

Applicant respectfully submits that the correct total Office delay, in view of the holding in *Wyeth v. Dudas*, should be the sum of the Period A type delays and the Period B type delay, which is 1,200 days. Therefore, the resulting PTA is the total Office delay (1,200 days) reduced by applicant's delay

MTC 6888.2  
40-21(52925)C US  
PATENT

(150 days), which is 1,050 days. As shown on Figure 2, none of the Period A type delays overlap with the Period type B delay.

In view of the above calculation applying the holding in *Wyeth*, Applicants request the Office to increase the PTA by 566 days. This correction will bring the total PTA to 1,050 days.

No terminal disclaimer was filed in this case.

A petition fee of \$200.00 under 37 C.F.R. §1.18(e) is submitted herewith. However, if additional fees are due, the commissioner is hereby authorized to charge the required fee to Deposit Account 19-1345.

Respectfully submitted,

/Andrew C. Wegman/

Andrew C. Wegman, Reg. No. 54,530  
SENNIGER POWERS LLP  
100 North Broadway, 17th Floor  
St. Louis, Missouri 63102  
(314) 345-7000

ACW/PDT

\* Attachment